



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,782	09/11/2003	Liat Mintz	28238	6045
26691	7590	11/15/2005	EXAMINER	
POTTER ANDERSON & CORROON LLP			DUNSTON, JENNIFER ANN	
ATTN: KATHLEEN W. GEIGER, ESQ.			ART UNIT	PAPER NUMBER
P.O. BOX 951			1636	
WILMINGTON, DE 19899-0951				

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	10/659,782	MINTZ, LIAT
	Examiner Jennifer Dunston	Art Unit 1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) The period for reply expires 3 months from the mailing date of the final rejection.

b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) They raise the issue of new matter (see NOTE below);
 (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): see continuation sheet.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 31 and 32.

Claim(s) objected to: _____.

Claim(s) rejected: 33,34,47 and 48.

Claim(s) withdrawn from consideration: 25-30 and 35-46.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. Other: _____.

CONTINUATION SHEET

Response to Amendment

The amendment filed 10/28/2005 under 37 CFR 1.116 in reply to the final rejection, mailed 8/25/2005, has NOT been entered.

The proposed amendments to the claims raise new issues that would require further search and consideration. For example, newly added claims 49-50 recite limitations requiring post-translational modifications of the claimed protein. These new claims would require further search and consideration.

The declaration under 37 CFR 1.132 filed 10/28/2005 is sufficient to overcome the rejection of claims 31-34 and 47-48 based upon lack of utility under 35 U.S.C. 101.

Response to Arguments

Applicant's arguments, see pages 7-9, filed 10/28/2005, with respect to the rejection of claims 31-34 and 47-48, as lacking utility under 35 U.S.C. 101, have been fully considered and are persuasive. The rejection of claims 31-34 and 47-48 has been withdrawn.

Applicant's arguments filed 10/28/2005 have been fully considered but they are not persuasive with regard to the rejection of claims 33 and 34 under 35 U.S.C. 112, first paragraph, as containing impermissible new matter. The response asserts that the original disclosure covers every possible fragment of SEQ ID NO: 32 having at least ten amino acids and amending the claims to cover a smaller scope logically includes the same disclosure. While the specification describes every possible fragment of SEQ ID NO: 32 having at least ten amino acids, there is no support for those fragments in combination with the limitation that requires at least one amino

Art Unit: 1636

acid of the fragment to be contiguous with an amino acid selected from amino acids 37-117 of SEQ ID NO: 32. Thus, the limitation “at least one contiguous amino acid from amino acids 37-117 of SEQ ID NO: 32” constitutes new matter. For these reasons, and the reasons made of record in the previous Office actions, this rejection is maintained.

Applicant's arguments filed 10/28/2005 have been fully considered but they are not persuasive with regard to the rejection of claims 33, 34, 47 and 48 under 35 U.S.C., first paragraph, as failing to comply with the description requirement. The response asserts that the disclosure supports fragments of SEQ ID NO: 32 having 90% identity thereto. However, this assertion is not supported by evidence. The arguments of counsel cannot take the place of evidence in the record. See MPEP 2145. Furthermore, as discussed on page 8 of the prior Office action, a nucleic acid sequence of 90% identity to nucleotides 112-462 of SEQ ID NO: 11 may actually encode a protein of less than 90% identity to the amino acid sequence of SEQ ID NO: 32. For these reasons, and the reasons made of record in the previous Office actions, this rejection is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is 571-272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1636

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR, <http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jennifer Dunston
Examiner
Art Unit 1636

jad

Terry McKelvey
TERRY MCKELVEY
PRIMARY EXAMINER